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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,626	01/24/2002	Kenji Fukuda	8001-1009	3592
466	7590	11/02/2005		
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER BAYERL, RAYMOND J	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/053,626	<b>Applicant(s)</b> FUKUDA, KENJI	
	<b>Examiner</b> Raymond J. Bayerl	<b>Art Unit</b> 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 - 4, 6 - 9, 13 - 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 6 - 9, 13 - 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 13 – 17 are objected to because of the following informalities:

At claim 13, lines 9 – 10, please note the grammatical difficulty with “while said user terminal [is?] accessing said server”.

At claim 15, line 2, “wherein said server selecting a file of a style” would read better with “selects” in place of “selecting”. A similar problem occurs with “converting” (claim 16, line 2) and “distributing” (claim 17, line 2).

Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 8 – 9, 13 – 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With claim 1 amended so that the “user terminals” are “storing display style information in a memory before first accessing the server”, how can it still be as in dependent claim 3, where “an access accompanied with no identification number” is such that “said distributor transmits select information” that is used to transmit “display style information”? In such a case, “before first accessing the server”, the “terminal” does not in fact possess the needed “style information” as in claim 1.

The phrase “the selection information” in claim 8 does not find clear antecedent basis in parent claim 1. Does this somehow refer to “display style information”? A similar problem exists with “the select information” in claim 9.

In claim 13, applicant's rewording of the file transmission to be a "user terminal receiving from said server" instead of "said server distributing a file" (lines 11 – 12) renders the subsequent phrase "received from said user terminal by said server to said user terminal" unclear, since "to said user terminal" had originally been the direction for the now-deleted "distributing". The Examiner suggests that the phrase "to said user terminal" could be safely deleted as superfluous, in view of the amendment.

With claim 13 amended so that "said user terminal" is "storing display style information...before first accessing said server", claim 17 appears inconsistent, in that "distributing select information" occurs "in response to a first access", as noted above with respect to claim 3.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Popa ("Popa"; US #6,006,231).

As per independent claim 18's "file distribution method for distributing a file of a style desired by a user terminal from a server to the user terminal via a network", Popa enables retrieving an image from a network, using a server application and a client application, so that a desired version of a desired image is sent via a communication application (Abstract). In Popa, an image file 12 may be accessed via a "request

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message for a specific file, resolution, size and colour space (col 5, line 36 - col 6, line 13; fig 3), so that the client application 20 enables an end user to select (manually or automatically) the image file, size, resolution, and colour, and creates the request message.

The Popa disclosure therefore anticipates claim 18, in that in Popa, the "user terminal" is capable of "storing display style information specifying a display style of a file", since the user develops a selection first at the client side, for subsequent transmission in a "request message", and also of "transmitting the display style information to the server on accessing the server", when the Popa server application receives such a request. The Popa "server" is then disclosed as "distributing a file of a style in accordance with the display style information to the user terminal", when the desired version is downloaded.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 6 - 9, 13, 15 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popa in view of Johnson ("Johnson"; US #6,615,213 B1).

Independent claim 1 (and see also independent claim 13) is similar to claim 18, discussed above as being anticipated by Popa, in that "user terminals storing display style information", each of which "transmits the display style information to said server", will obtain "a file of a style in accordance with the display style information". Popa,

however, appears directed to a scenario in which the client and the server have a certain predefined relationship, and thus does not **explicitly** teach the “storing” of “display style information in a memory before first accessing the server”, since Popa’s server would most likely have been already accessed in some sort of setup procedure.

However, it was known in the art at the time of applicant’s invention to maintain “user terminal” specifics that are directed towards a variety of “server” instances, as is seen in Johnson, in which application independent data is maintained, so as to permit configured customizable actions (Abstract). In Johnson, data may be sought by many various remote data processing systems (col 2, line 66 - col 3, line 34), and is for automatically communicating (transmitting) to as many remote data processing systems as desired through the minimal user action. It is seen in Johnson, therefore, a generic foundation for facilitating the communication of data by clients to arbitrary remote applications (col 3, lines 39 - 50), so that the application independent data is stored “before first accessing” “a server connected to a network”, when one of the many various remote data processing systems is being accessed for the first time.

It would have been obvious to a person having ordinary skill in the art at the time applicant’s invention was made to provide “display style information” such as that which is used in obtaining an image file instance of a particular version from a server, as in Popa, but with the client having such information on hand “before first accessing the server”, as in Johnson, because this allows a greater variety of servers to be image file sources, a capability readily appreciated in the Popa environment. Motivation rests at least in Popa, where it is the objective to provide the best copy of an image file that the

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client can support, and this would be enhanced with a wider variety of sources as per Johnson that do not require separate configuration (e.g., using the same application independent data, Johnson).

As per claim 6's "server" whose "memory previously stores a plurality of files having different display styles" (see also claim 15), because Popa can develop a plurality of different versions of the image (col 1, lines 49 - 59), Popa will have to have such storage for a "distributor" that "selects a corresponding file" and "distributes the file to the user terminal". Also, please note that in Popa, each version of the image is derived from the same file, as in claim 7's "original file" that is made to have "a style" by the use of a "converter" (see also claim 16).

As per claim 8, Popa discloses that the user can download any combination of resolution, dimension and colour quality contained in the original image (col 3, lines 7 - 31) for a desired image file. Thus, "presence of an image" is included in the identity of the file, and "size" "of an image and a size of a display screen" in size (col 3, lines 19 - 31). This aspect of Popa also satisfies claim 9, in which "a display resolution" is part of "the select information".

8. Claims 2 - 4, 14, 17 are rejected under 35 USC 103(a) as being unpatentable over Popa in view of Johnson and Ovadya et al. ("Ovadya"; US #2001/0009008 A1).

In any arrangement that accesses a "server" in the style of Popa or Johnson, the user identity would certainly be important, where any kind of value-added service is being provided, only these references do not **explicitly** teach claim 2's "identification

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number generator” that is used at the “distributor” side to retain “display style information”.

However, Ovadya’s ONLINE SERVICE PLATFORM specifically contemplates such user-by-user “identification”, when file conversions, translations or any other service being executed on a file (Abstract) are provided, via a customer identification (customer client ID) 19, which is a code identifying the customer client and a browser 20 (paragraphs [0014], [0019]).

Thus, it would have been further obvious to the person having ordinary skill in the art to use an “identification number” as per Ovadya, to retain the kind of user-specifics that would be useful in a “display style” provision as per Popa, when made to have the further capability of “storing” such information “before first accessing” a “server” as in Johnson, because this gives the “server” side a better control over the individual accessing users in a typical Popa situation, where the relationship retention as in Ovadya allows for optimum customization and support. Motivation can be seen in either of Popa or Johnson, where the accessing user seeks an extent of custom access that is as suitable as possible to that user’s needs, in obtaining information from the “server”.

In such a combination, the initially-arriving user will first need to make a connection as per Ovadya, but with “no identification number” (claim 3, see also the comparable claim 17), since the “server” has not yet been contacted. In this situation, the “distributor transmits select information” to indicate what is available, as in Ovadya’s provision of an HTML document holding information about possible file processing (paragraph [0019]). Such a user dialogue could well be expected in the Popa



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environment, where the client side would be better served if notified upon a first contact as in Johnson's multi-server applicability of what exact versions might be obtained.

When the user has made such a first contact and obtained an "identification number" (as suggested by Ovadya), the "user terminals" will retain "the identification number and location information of said server" that has given them (claim 4).

Thus suggested by the additional obvious addition of Ovadya-style customer identification is claim 14's "server holding the display style information" and a "user terminal holding the identification number", for obtaining "a file of a style in accordance with the display style information", when a Popa "style" maintained for plural "server" instances as in Johnson, is adapted to allow individual users to be identified.

9. Applicant's arguments with respect to claims 1 – 4, 6 – 9, 13 – 18, filed 28 September 2005, have been considered but are moot in view of the new ground(s) of rejection.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


In a new and updating search made pursuant to applicant's amendment, it was also noted that Sutherland et al. (US #6,167,442) obtains files from a plurality of image databases in a "style" such as at the best resolution (Abstract).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

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12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (571) 273-8300.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



**RAYMOND J. BAYERL**  
**PRIMARY EXAMINER**  
**ART UNIT 2173**

31 October 2005